

Application No. 10/623,588
Amendment dated April 11, 2008
Reply to Examiner's Answer of February 11, 2008

REMARKS

Reconsideration and Allowance Are Respectfully Requested

Claims 1-20 are currently pending. Claims 1, 2, 4, 7, 8, 9, 16, and 17 have been amended. No claims have been canceled. No claims have been added. No new matter has been introduced. Reconsideration is respectfully requested.

NEW GROUNDS OF REJECTION

Claims 1-20 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over U.S. Design Patent No. D485,757 to Roth et al. (Roth) in view of U.S. Patent No. 5,996,191 to Christler (Christler). Claims 1-3, 5-6, 8-11, 13, 15-18 and 20 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over U.S. Design Patent No. D433,562 to Redlinger (Redlinger) in view of U.S. Patent No. 5,996,191 to Christler (Christler). Claims 2, 9 and 17 stand rejected under 35 U.S.C. § 112, second paragraph. These rejections are respectfully traversed in view of the preceding amendments and the remarks which follow.

I. CLAIMS 1-20 ARE PATENTABLE OVER ROTH IN VIEW OF CHRISTLER

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roth in view of Christler. With reference to amended claim 1, Applicant has claimed a dispensing container with a selectively removable cap to which a variety of articles may be securely and selectively attached. The dispensing container has a dispensing body in which material for dispensing is stored. The dispensing body has a closed end, a side wall, an open end through which the material is dispensed and a cap shaped and dimensioned for selectively covering the open end of the dispensing body.

The cap has a first end shaped and dimensioned for engaging the open end of the dispensing body for secure and selective attachment thereto and a closed second end with a clasp extending therefrom. The clasp has a first arm and a second arm integrally formed with the cap. The first arm has a first arcuate member and a first upwardly extending connecting member linking the first arcuate member to the cap. The second arm has a second arcuate member and a second upwardly extending connecting member linking the second arcuate member to the cap. The first arm and the second arm are oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm. Further, the first arcuate member and the second arcuate member overlap through a substantial portion of their respective arcs

The Examiner's Answer generally contends that Roth teaches a dispensing container with an integrally formed hook and gate which allows the device to be attached to an object, but the hook and gate do not teach a first arcuate portion and a second arcuate portion which overlap along a substantial portion of their respective arcs. In an attempt to overcome the clear deficiencies in the disclosure of Roth, the Examiner relies upon the teaching of the hookless connecting ring of Christler, arguing the modification of Roth based upon Christler is motivated by the benefit of providing a resilient closed loop connection equally capable of securing the ring to an object.

In establishing the law governing obviousness-type rejections, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy... This is not to say, however, that there will not be difficulties in applying the nonobviousness

test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

With the foregoing in mind, the U.S. Patent & Trademark Office has determined that a *prima facie* case of obviousness is established by meeting three basic criteria. First, the Examiner must show some suggestion or motivation to modify the reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success in modifying the primary reference based upon the teachings of the prior art. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Support for the proposed modification and the reasonable expectation of success must be found in the prior art. MPEP 706.02(j).

Considering the criteria required, the Examiner has failed to meet the requirements set forth in the MPEP in establishing a *prima facie* case of obviousness. First, the motivation suggested by the Examiner, that is, creating a benefit of providing a resilient closed loop connection equally capable of securing the ring to an object, is not supported by the cited references and is merely made up to create a rejection. There is no logical reason why one would modify the so-called hook and gate clasp of Roth to include a hookless connecting ring as taught by Christler. More specifically, it does not logically flow to make something that includes a hook into something hookless. Quite simply, the teachings of Christler provide no benefit to Roth. The application of the structure disclosed by Christler would make Roth inoperative or operate in a manner not intended by Roth.

There is nothing in Roth which teaches a desire or structure used to attach the lid to an object. There is also nothing in the design showing a selectively removable cap. One cannot assume

the lid of Roth is selectively removable. In fact, it turns out that when the disclosure of Roth's utility application is reviewed, this assumption is incorrect. What is shown in the design of Roth when read in light of the utility application is a lid that is hinged and is flipped open and closed, not a lid which is selectively removable from a bottle. Further, there is nothing showing a cap having a first end shaped and dimensioned for engaging an open end of a dispensing body for secure and selective attachment thereto and a closed second end with a clasp extending therefrom. Again, it turns out the Examiner's assumption is incorrect when read in light of the utility application, the lid shown in the Roth design is not attached to the bottle, but is attached to a base portion 26 of a closure. There is also absolutely no support in Roth that the lid for a bottle shown includes a clasp. There is no indication that the structure shown in the design functions to attached to objects. There is further no indication that the structure shown is at all resilient. A design is simply an ornamental showing and does not include a functional disclosure. Thus, and as clearly shown above, one cannot merely make assumptions regarding what is shown in a design patent in order to create rejections.

Contrary to the Examiner's opinion that a portion of the loop functions as a gate because it has a reduced thickness, all Roth can be relied upon for showing is a tear drop shaped loop with a slit. It does not disclose a gap and overlapping arcuate members. The reduced thickness and slit are merely part of the design. Again, the Examiner is merely making impermissible assumptions. Without a disclosure of the function of the device disclosed by Roth, the Examiner is left only with the design of Roth, and nothing more.

Even based upon these incorrect assumptions, why would one of ordinary skill in the lid art look to Christler for a teaching? Christler is not concerned with lids for bottles. Still further, the structure of Christler is not, nor can it be determined to be, essentially the same as that of Roth.

There is no disclosure in Roth teaching resilient distortion. Additionally, the resilient distortion in Christler is not the same as that in Appellant's invention or that contemplated in Roth (that is, if one could rely on the complete specification of the Roth utility patent application, which is not permitted). Christler's arms 14, 16 separate sideways relative to one another. They do not separate up and down relative to each other. Following the same thickness logic of the Examiner, the portions of the loop in Roth certainly don't appear as though they can move sideways relative to one another. So assuming the bottom portion of the loop of Roth is a gate, it would move towards the opposed portion of the loop to permit the slit to get larger. As such, why would it be obvious to modify it in view of Christler so it could move sideways instead of its intended direction of movement? This would require the complete reengineering and design of the device disclosed by Roth.

The Examiner has also failed to show a reasonable expectation of success in modifying the primary reference Roth based upon the teachings of the Christler. The Examiner states that Roth is made from a thicker gauge material than the ring of Christler (which again is not supported by the references and is merely made up). If Roth is made from a thicker gauge material, how is it possible that it could flex sideways as taught by Christler? As seen in Figure 1 of Christler, a moment arm M_b is created as arms 14 and 16 move in and out of the paper as they are separated. Referring to Figure 2 of Christler, a moment arm M_t is created by moving the arms sideways relative to each other. Thus, the proposed modification shows no reasonable expectation of success.

Quite simply there is no motivation to combine Roth with Christler and, even if combined, it is not shown how Applicant's claimed invention is the logical result.

In independent claim 8, Applicant has specifically claimed the first arm includes a first arcuate member extending along an arc of at least 120 degrees and a first upwardly extending connecting member linking the first arcuate member to the cap. The second arm includes a second arcuate member extending along an arc of at least 120 degrees and a second upwardly extending connecting member linking the second arcuate member to the cap. The first arm and the second arm are oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm, the first arcuate member and the second arcuate member overlapping through at least a 60 degree arc.

The Examiner somehow addresses these limitations by again making assumptions. This assumption now relates to the size of Christler and is not based upon the teachings of Christler. The overlap in Christler is certainly not 60 degrees and there is no overlap in Roth. So, how is it taught by the references that when combined a 60 degree overlap is the result? Although Christler does indicate the overlap can be adjusted, his desire is to have it be four times the width of the material the ring is made from. Christler indicates no desire to provide for an overlap of 60 degrees.

The arguments presented above generally deal with the "pre-KSR world". In view of the new "Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc.*", Appellant has attempted to address various issues that may not have been contemplated by the Examiner prior to the rendering of a decision in *KSR*. In particular, the Examination Guidelines set forth various proposed rationales for articulating why a claimed invention would in fact be obvious. After reviewing the proposed rationales and considering the rejection in the outstanding application, it is quite possible one might attempt to apply the following rationales in supporting or explaining the rationale for obviousness in

the present application; (1) applying a known technique to a known device ready for improvement to yield predictable results; (2) known work in one field of endeavor may prompt variation of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; or (3) some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

With regard to the first rationale listed above, that is, applying a known technique to a known device, the Examination Guidelines indicate that an Examiner must first provide a finding that the prior art contains a base device upon which the claimed invention can be seen as an improvement. Presumably, the base device would be that disclosed by Roth in Design Patent No. D485,757. Thereafter, the Examiner must present a finding that the prior art contained a known technique that is applicable to the base device. Presumably, the Examiner would argue this is taught by Christler. Finally, the Examiner must present a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system. This is where the Examiner would certainly fail to find support for the factual inquiry required under *KSR*. In particular, and as fully discussed above, Roth fails to teach a resilient clasp and Christler fails to teach a resilient clasp on a cap as claimed. Christler merely teaches a hookless locking ring. With this in mind, why would the claimed invention be a predictable modification of the cited references? What is truly the predictability of adding a hookless locking ring to a dispensing cap and resulting in the claimed invention? The only reasonable conclusion is the design of Roth would now be altered in an undesirable fashion. In fact,

if the structure of Roth is a hook and gate it would no longer function as intended once modified as suggested by the Examiner.

As to the second rationale for obviousness, that is, that known work in one field of endeavor may prompt variation of it for use in either the same field or a different one based on design incentives or other market forces, this rationale first requires that the scope and content of the prior art, whether in the same field of endeavor as that of Appellant's invention or a different field of endeavor, included a similar analogous device. Presumably, the scope and content of the prior art would include the disclosures of Roth and Christler. Thereafter, the Examiner must provide a finding that there were design incentives or market forces which would have prompted adaptation of the known device. At the current time, and absent the disclosure of the present application, there are no design incentives or market forces which would have prompted one to modify either Roth or Christler so as to read upon the pending claims. Further, and even if one were able to find such incentives, the Examiner must find that the differences between the claimed invention and the prior art were encompassed in known variations or in principles known in the prior art. Once again, Roth and Christler fail to provide support for this required finding, as what Appellant has claimed is not encompassed in these references. The Examiner's rationale regarding varying or obtaining a particular biasing force is has nothing to do with the claimed invention.

Finally, and with regard to the third rationale, that is, that some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention, the Examiner would once again fail to find a sufficient finding of obviousness to support a rejection under 35 U.S.C. § 103 and KSR. In particular, this rationale requires that the Examiner present a finding that there was

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some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Presumably, Roth and Christler are the references and, as discussed above, neither of these references provides any teaching to support the concept that one would desire to provide a clasp as claimed on a dispenser cap. Again, the Examiner's rationale regarding varying or obtaining a particular biasing force is has nothing to do with the claimed invention.

In view of the above remarks, it is respectfully requested that the rejection of claims 1-20 under Roth in view of Christler be withdrawn.

II. CLAIMS 1-3, 5-6, 8-11, 13, 15-18 and 20 ARE PATENTABLE OVER REDLINGER IN VIEW OF CHRISTLER

Even if it is obvious to modify Redlinger to replace the ring shown therein with the ring taught by Christler, this modification does not result in the claimed invention.

Although Redlinger does show a dispensing container including a selectively removable cap to which a variety of articles may be securely and selectively attached, Redlinger fails to disclose a closed second end including a clasp extending therefrom, wherein the clasp includes a first arm and a second arm integrally formed with the cap as claimed. The integrally formed first arm includes a first arcuate member and a first upwardly extending connecting member linking the first arcuate member to the cap, and the integrally formed second arm includes a second arcuate member and a second upwardly extending connecting member linking the second arcuate member to the cap.

Redlinger also fails to disclose a clasp wherein the first arm and the second arm are oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm, the first arcuate member and the second arcuate member overlapping through a substantial portion of their respective arcs.

The teachings of Christler fail to remedy the deficiencies of Redlinger. Ultimately, the combination of Redlinger and Christler fail to teach an integral clasp extending from the closed end of the cap and there is no reason one of ordinary skill in the art would make the ring of Christler integral with the cap. This proposed modification would destroy the function of the key ring shown in both Redlinger and Christler as key rings are intended to rotate and not be fixed.

In view of the preceding amendments and remarks, it is respectfully requested that the rejection of claims 1-3, 5-6, 8-11, 13, 15-18 and 20 under Redlinger in view of Christler be withdrawn.

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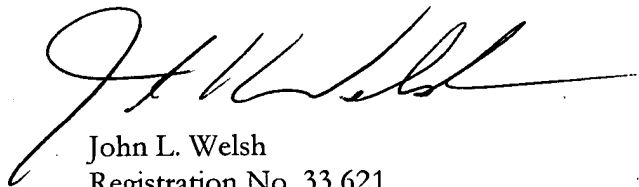
III. REJECTION OF CLAIMS 2, 9 AND 17 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH.

With regard to the rejection of claims 2, 9 and 17 under 35 U.S.C. § 112, it is now deemed to be moot in view of the current amendments to the claims.

Since the prior art rejections in view of Roth and Christler and Redlinger and Christler have now been shown to be improper and the 112 rejection has been overcome, the application is now believed to be in condition for allowance.

It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact Applicant's representative at the below number.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. L. Welsh', with a long horizontal flourish extending to the right.

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